

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/650,564)	Title:
Patent No. : 7,917,163)	Intra-Frequency Searching in the
)	Presence of Frequency Gaps
Inventor(s) : Messay Amerga)	
)	
Attorney Docket No. : 020673)	Filing Date : August 27, 2003
)	
Group Art Unit: 2618)	Issue Date : March 29, 2011

DECLARATION OF VENUGOPAL MENON

I, Venugopal Menon, declare as follows:

1. I am an employee of MaxVal Group, Inc. (hereinafter "MaxVal"), located at 2251 Grant Road, Suite B, Los Altos, CA 94024, which provides patent related services to Qualcomm Inc. (hereinafter "Qualcomm") located at 5775 Morehouse Drive, San Diego, CA 92121, the owner/assignee of the above referenced patent. MaxVal performs Patent Term Adjustment (hereinafter "PTA") verifications on behalf of Qualcomm. My responsibility, as a PTA Team Lead in MaxVal, is to perform PTA calculations before they are mailed out to Qualcomm.
2. I created a process and trained my team to follow such process to extract IFW and PTA data from Public PAIR in order to perform PTA verifications. The process steps included copying the table from the "Patent Term Adjustments" tab in the record of an application from Public PAIR and pasting it into an Excel spreadsheet (I named this tab on the Excel spreadsheet "PTO-PTA"). During the normal course of business within my duty to perform the above responsibility in calculating the PTA of the above referenced application, I cross-checked my calculations from the process against the values that appeared in the PTO-PTA tab. I emailed this Excel spreadsheet to Qualcomm upon completion of the verification exercise. The Excel spreadsheet that was used to compute PTA at the Notice of Allowance for the above captioned case is attached as Exhibit A.

I believed that even though the PTO-PTA tab of the Excel spreadsheet may not have been a static screen capture of the "Patent Term Adjustments" tab from Public PAIR, the cells of the PTO-PTA sheet contained unaltered PTA data, such as that shown in sheets 4 and 5 of Exhibit A.

On November 30, 2010, a Notice of Allowance (hereinafter "NOA") for the above captioned application, which subsequently issued as the above-captioned patent (hereinafter the "'163 patent") was mailed to Qualcomm. The PTA page of the NOA letter is attached herewith as Exhibit B. The NOA published a PTA of 697 days. The delay values I used in calculating PTA for the above-captioned application were as follows:

- A delays – 961 days;
- Non-overlapping USPTO Delays - 961 days;
- Applicant Delays - 264 days.

My calculation of 697 days of PTA (961 days of Office A-delay less 264 days of Applicant Delay) was based on the values as shown in Exhibit A and was in agreement with the USPTO's value as shown in the NOA (see Exhibit B)

On January 12, 2011, I emailed the results of the PTA verification to Qualcomm.

On March 29, 2011, the '163 patent issued with a PTA of 856 days. The USPTO's calculation was based on the following delay periods (taken from the PTA tab on Public PAIR after issuance):

- A Delays – 961 days;
- B Delays – 582 days;
- Overlapping delays between {A and B} or {A and C} – 292 days;
- Non-overlapping USPTO Delays - 1251 days;
- Applicant Delays - 395 days.

However, my calculation yielded 987 days of PTA. The Applicant Delay used in my calculation was the same value as it was in the NOA case, viz, 264 days.

When I noticed the difference in the total Applicant Delay (and consequently, the PTA) arrived at by the USPTO and my team in MaxVal, I compared the PTO-PTA tab of

the Excel spreadsheet that we mailed to the client in January 12, 2011 (Sheets 4 and 5 of Exhibit A) against the PTA tab of the issued patent in Public PAIR and noticed the discrepancy described below. A copy of the screen capture of the PTA tab from PAIR is attached herewith as Exhibit C which shows a 131-day applicant delay entered in line 59 of the IFW (corresponding to the transaction "PETITION TO REVIVE APPLICATION -- GRANTED" dated 5/17/2010) that was missing in the PTA tab on PAIR at Allowance.

On May 2, 2011, I brought this discrepancy to the attention of the Qualcomm attorney responsible for PTA.

3. Prior to the events described above, I personally had not seen another instance of a PTA calculation where the USPTO inserted a delay period (pre-dating the NOA date) into the record after accepting the payment of issue fees.
4. I declare further that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true. These statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. § 1001, and that such willful false statements may jeopardize the validity of this patent issued from the application.

Signed:



Date: May 26, 2011

Venugopal Menon

PTA CALCULATION FOR 10/650,564

Application No.	10/650,564
Title	INTRA-FREQUENCY SEARCHING IN THE PRESENCE OF FREQUENCY GAPS
Filing or 371(c) Date	8/27/2003
NOA Date	11/30/2010
3 Year cut off date	8/27/2006
A (PTO)	961
A (App/Exam)	264
B	0
A-B over/under	0
PTO calculated PTA	697
Extension	697
Potential Extension beyond PTO-calculated PTA	0

not calculated for NOA

Extension calculated under 35 USC 154(b) in view of the Wyeth decision.

Terminal Obelisk/Ref	N/A
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44729005	C14P	CLAMS	APPLICANT ARGUMENTS/REMARKS MADE IN AN ADVERTISEMENT	0
44729006	REMA	PER NOTIFICATION (PFD 875)		
44729008	WYSE	PER NOTIFICATION (PFD 875)	PER NOTIFICATION (PFD 875)	963
44729009	WYSE	PER NOTIFICATION (PFD 875)	PER NOTIFICATION (PFD 875)	
44729010	CY9E	FINAL REACTION		
44729012	FANCL	WYSE OF CLAMS		
44729013	SEAR	SEARCH INFORMATION INCLUDING CLAIMS, INITIAL DATA, AND OTHER SEARCH		
44729017	AWP	SEARCH INFORMATION INCLUDING CLAIMS, INITIAL DATA, AND OTHER SEARCH		
44729018	CLAMS	CLAMS		
44729019	REMA	APPLICANT ARGUMENTS/REMARKS MADE IN AN ADVERTISEMENT		
44729020	NALP	PER NOTIFICATION (PFD 875)	PER NOTIFICATION (PFD 875)	
44729021	CY9E	FINAL REACTION		
44729022	SE2	LIST OF REFERENCES CITED BY EXAMINER		
44729027	SB	BOLD/STANDARD DATA SHEET		
44729028	WYSE	WYSE OF CLAMS		
44729029	AWP	SEARCH INFORMATION INCLUDING CLAIMS, INITIAL DATA, AND OTHER SEARCH		
44729030	REMA	RELATED NOTES		
44729031	SEAR	EXAMINER'S SEARCHES (PATIO) AND REMA IS		
44729032	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729033	CLAMS	CLAMS		
44729035	AWP	AWP		
44729037	REMA	REMA		
44729038	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729039	CLAMS	CLAMS		
44729040	AWP	AWP		
44729043	REMA	REMA		
44729044	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729045	CLAMS	CLAMS		
44729046	AWP	AWP		
44729047	REMA	REMA		
44729048	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729049	CLAMS	CLAMS		
44729050	AWP	AWP		
44729051	REMA	REMA		
44729052	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729053	CLAMS	CLAMS		
44729054	AWP	AWP		
44729055	REMA	REMA		
44729056	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729057	CLAMS	CLAMS		
44729058	AWP	AWP		
44729059	REMA	REMA		
44729060	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729061	CLAMS	CLAMS		
44729062	AWP	AWP		
44729063	REMA	REMA		
44729064	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729065	CLAMS	CLAMS		
44729066	AWP	AWP		
44729067	REMA	REMA		
44729068	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729069	CLAMS	CLAMS		
44729070	AWP	AWP		
44729071	REMA	REMA		
44729072	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729073	CLAMS	CLAMS		
44729074	AWP	AWP		
44729075	REMA	REMA		
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44729078	AWP	AWP		
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44729081	CLAMS	CLAMS		
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44729083	REMA	REMA		
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44729085	CLAMS	CLAMS		
44729086	AWP	AWP		
44729087	REMA	REMA		
44729088	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729089	CLAMS	CLAMS		
44729090	AWP	AWP		
44729091	REMA	REMA		
44729092	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729093	CLAMS	CLAMS		
44729094	AWP	AWP		
44729095	REMA	REMA		
44729096	TEMA	TRANSMITTAL OF NEW APPLICATION		
44729097	CLAMS	CLAMS		
44729098	AWP	AWP		
44729099	REMA	REMA		
44729100	TEMA	TRANSMITTAL OF NEW APPLICATION		
447				

Patent Term Adjustment

Filing or 371(c) Date:	8/27/2003	Overlapping Days Between (A and B) or (A and C):	0
Issue Date of Patent:	-	Non-Overlapping USPTO Delays:	961
A Delays:	961	PTO Manual Adjustments:	0
B Delays:	0	Applicant Delays:	264
C Delays:	0	Total PTA Adjustments:	697

Patent Term Adjustment History

Explanation Of Calculations:

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
83	2010-11-30	MAIL NOTICE OF ALLOWANCE			0
84	2010-11-23	ISSUE REVISION COMPLETED			0
83	2010-11-23	DOCUMENT VERIFICATION			0
82	2010-11-23	NOTICE OF ALLOWANCE DATA VERIFICATION COMPLETED			0
81	2010-11-18	EXAMINER'S AMENDMENT COMMUNICATION			0
80	2010-11-18	NOTICE OF ALLOWABILITY			0
79	2010-9-22	DATE FORWARDED TO EXAMINER			0
77	2010-9-22	RESPONSE AFTER NON-FINAL ACTION			0
76	2010-6-24	ELECTRONIC REVIEW			0
75	2010-6-24	EMAIL NOTIFICATION			0
74	2010-6-24	MAIL NON-FINAL REJECTION			0
73	2010-6-21	NON-FINAL REJECTION			0
72	2010-6-14	DATE FORWARDED TO EXAMINER			0
71	2010-3-5	RCE - AF PROCESSED			0
70	2010-5-18	REQUEST FOR CONTINUED EXAMINATION (RCE)		235	46
69	2010-6-14	DISPOSAL FOR A RCE / CPA / R129			0
68	2010-6-4	EMAIL NOTIFICATION			0
67	2010-5-28	DATE FORWARDED TO EXAMINER			0
66	2010-6-2	MAIL NOTICE OF RESCINDED ABANDONMENT			0
65	2010-5-28	NOTICE OF RESCINDED ABANDONMENT IN TCS			0
64	2010-5-21	ELECTRONIC REVIEW			0
63	2010-5-21	EMAIL NOTIFICATION			0
62	2010-5-20	EMAIL NOTIFICATION			0
61	2010-5-21	PG-PUB NOTICE OF NEW OR REVISED PROJECTED PUBLICATION DATE			0
60	2010-5-18	MAIL-PETITION TO REVIVE APPLICATION - GRANTED			0
59	2010-5-17	PETITION TO REVIVE APPLICATION - GRANTED			0
58	2010-3-5	PETITION ENTERED			0
57	2010-3-5	WORKFLOW - REQUEST FOR RCE - BEGIN			0
56	2010-1-6	EMAIL NOTIFICATION			0
55	2010-1-6	MAIL ABANDONMENT FOR FAILURE TO RESPOND TO OFFICE ACTION			0
54	2010-1-4	ABAND. FOR FAILURE TO RESPOND TO O. A.			0
53	2009-9-3	EMAIL NOTIFICATION			0
52	2009-9-3	MAIL ADVISORY ACTION (PTOL - 303)			0
51	2009-8-28	ADVISORY ACTION (PTOL-303)			0
50	2009-8-26	DATE FORWARDED TO EXAMINER			0
49	2009-8-25	AMENDMENT AFTER FINAL REJECTION			0
48	2009-6-25	ELECTRONIC REVIEW			0
47	2009-6-25	EMAIL NOTIFICATION			0
46	2009-6-25	MAIL FINAL REJECTION (PTOL - 326)			0
45	2009-6-22	FINAL REJECTION			0
44	2009-4-17	DATE FORWARDED TO EXAMINER			0
43	2009-3-5	RESPONSE AFTER NON-FINAL ACTION			0
42	2008-12-12	ELECTRONIC REVIEW			0
41	2008-12-12	EMAIL NOTIFICATION			0
40	2008-12-12	MAIL NON-FINAL REJECTION			0
39	2008-12-8	NON-FINAL REJECTION			0
37	2008-10-5	DATE FORWARDED TO EXAMINER			0
36	2008-8-27	RESPONSE AFTER NON-FINAL ACTION			0
35	2008-5-30	ELECTRONIC REVIEW			0
34	2008-5-29	EMAIL NOTIFICATION			0
33	2008-5-29	MAIL NON-FINAL REJECTION			0
32	2008-5-23	NON-FINAL REJECTION			0
31	2008-4-16	DATE FORWARDED TO EXAMINER			0
30	2008-4-1	AMENDMENT SUBMITTED/ENTERED WITH FILING OF CPA/RCE			0
29	2008-4-16	DATE FORWARDED TO EXAMINER			0
28	2008-4-1	REQUEST FOR CONTINUED EXAMINATION (RCE)		29	22
27	2008-4-16	DISPOSAL FOR A RCE / CPA / R129			0
26	2008-4-1	REQUEST FOR EXTENSION OF TIME - GRANTED			0
25	2008-4-1	WORKFLOW - REQUEST FOR RCE - BEGIN			0

24	2007-12-5	ELECTRONIC REVIEW		0
23	2007-12-4	EMAIL NOTIFICATION		0
22	2007-12-3	MAIL FINAL REJECTION (PTOL - 326)		0
21	2007-11-26	FINAL REJECTION		0
20	2007-9-19	DATE FORWARDED TO EXAMINER		0
19	2007-9-11	RESPONSE AFTER NON-FINAL ACTION		0
18	2007-6-21	ELECTRONIC REVIEW		0
17	2007-6-20	EMAIL NOTIFICATION		0
16	2007-6-15	MAIL NON-FINAL REJECTION	961	0.5
15	2007-6-7	NON-FINAL REJECTION		0
14	2007-4-17	CASE DOCKETED TO EXAMINER IN GAU		0
13	2007-4-12	IPW TSS PROCESSING BY TECH CENTER COMPLETE		0
12	2007-4-11	CASE DOCKETED TO EXAMINER IN GAU		0
11	2006-12-12	TRANSFER INQUIRY TO GAU		0
10	2006-8-3	TRANSFER INQUIRY TO GAU		0
9	2004-3-26	TRANSFER INQUIRY TO GAU		0
8	2003-11-19	APPLICATION RETURN FROM OIPE		0
7	2003-11-19	APPLICATION RETURN TO OIPE		0
6	2003-11-19	APPLICATION DISPATCHED FROM OIPE		0
5	2003-11-19	APPLICATION IS NOW COMPLETE		0
4	2003-11-10	CASE CLASSIFIED BY OIPE		0
3	2003-11-10	CLEARED BY OIPE CSR		0
2	2003-10-14	IPW SCAN BAMP; PACR AUTO SECURITY REVIEW		0
1	2003-8-27	INITIAL EXAM TEAM NN		0
0.5	2003-8-27	FILING DATE		0

NOA

<u>B Delays</u>	<u>Date</u>	<u>Days</u>
Filing Date (Actual whether national or NP)	8/27/2003	
Issue Date		
3 year cut-off date	8/27/2006	
First RCE Filing Date		
B Delay (a)		<u>-38,956</u>
Interference		0
Interference Declared Date		
Interference Terminated Date		
Appeal		0
(Day) Notice of Appeal Filed Date		
(Day) Decision Date		
Secrecy Order		0
Secrecy Order Filed Date		
Secrecy Removed Date		
Applicant requested Delays		0
Start Date		
End Date		
B DELAY		0

EXHIBIT B



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Lorton, VA 22079-4350
U.S. Patent and Trademark Office
Washington, D.C. 20530-0001
P.O. Box 1000

APPLICATION NO.	FILING DATE	TITLE NAMED INVENTOR	ATTORNEY'S REF. NO.	COMPLETION NO.
09/001,001	09/27/2000	Message Archive	120073	8217

NAME: NAME: 11/001,001

QUALCOMM INCORPORATED
5775 MOREHOUSE DR.
SAN DIEGO, CA 92121

SIGNATURE

SIGNATURE

NAME: NAME: 11/001,001

NAME: NAME: 11/001,001

Determination of Patent Term Adjustment under 35 U.S.C. 154 (b) (application filed on or after May 29, 2000)

The Patent Term Adjustment to date is 697 day(s). If the issue fee is paid on the date that is three months after the mailing date of this notice and the patent issues on the Tuesday before the date that is 28 weeks (six and a half months) after the mailing date of this notice, the Patent Term Adjustment will be 697 day(s).

If a Continued Prosecution Application (CPA) was filed in the above-identified application, the filing date that determines Patent Term Adjustment is the filing date of the most recent CPA.

Applicant will be able to obtain more detailed information by accessing the Patent Application Information Retrieval (PAIR) WEB site (<http://pair.uspto.gov>).

Any questions regarding the Patent Term Extension or Adjustment determination should be directed to the Office of Patent Legal Administration at (571)-272-7702. Questions relating to issue and publication fee payments should be directed to the Customer Service Center of the Office of Patent Publication at 1-(888)-786-0101 or (571)-272-4200.

EXHIBIT C

5/25/2011 portal.uspto.gov/external/PTA_PTA/PAT/P...

10/25/2011 INTRA-FREQUENCY SELECTIONS IN THE PRESENCE OF FREQUENCY GAPS 05-25-2011 15:47:35

Patent Term Adjustments

Patent Term Adjustment (PTA) for Application Number: 10/550,564

Filing or 371(c) Date:	08-27-2003	Overlapping Days Between (A and B) or (A and C):	292
Issue Date of Patent:	03-29-2011	Non-Overlapping USPTO Delays:	1251
A Delays:	961	PTO Manual Adjustments:	0
B Delays:	552	Applicant Delays:	395
C Delays:	0	Total PTA Adjustments:	856

Patent Term Adjustment History Explanation Of Calculations

Number	Date	Contents Description	PTO(Days)	APPL(Days)	Start
97.5	03-31-2008	PTA 36 Months	582		0.5
97	03-29-2011	Patent Issue Date Used in PTA Calculation			0
96	03-02-2011	Export to Final Data Capture			0
95	02-25-2011	Dispatch to FDC			0
94	02-25-2011	Application Is Considered Ready for Issue			0
93	03-23-2011	Issue Fee Payment Verified			0
92	02-23-2011	Issue Fee Payment Received			0
91	01-19-2011	Finished Initial Data Capture			0
85	11-30-2010	Mail Notice of Allowance			0
84	11-23-2010	Issue Revision Completed			0
83	11-23-2010	Document Verification			0
82	11-23-2010	Notice of Allowance Data Verification Completed			0
81	11-18-2010	Examiner's Amendment Communication			0
80	11-18-2010	Allowability Notice			0
78	09-22-2010	Data Forwarded to Examiner			0
77	09-21-2010	Response after Non-Final Action			0
76	06-24-2010	Electronic Review			0
75	06-24-2010	Email Notification			0
74	06-24-2010	Mail Non-Final Rejection			0
73	06-21-2010	Non-Final Rejection			0

portal.uspto.gov/PTA/PAT/PTA.html 1/4

EXHIBIT C

5/25/2011	portal.uspto.gov/external/PA_PetPub/P...			
72	06-14-2010	Date Forwarded to Examiner	0	
71	03-05-2010	RCE- AF Processed	0	
70	05-18-2010	Request for Continued Examination (RCE)	235	46
69	06-14-2010	Disposal for a RCE / CPA / R129	0	
68	06-04-2010	Email Notification	0	
67	05-28-2010	Date Forwarded to Examiner	0	
66	06-02-2010	Mail Notice of Rescinded Abandonment	0	
65	05-28-2010	Notice of Rescinded Abandonment in TCs	0	
64	05-21-2010	Electronic Review	0	
63	05-21-2010	Email Notification	0	
62	05-20-2010	Email Notification	0	
61	05-21-2010	PG-Pub Notice of new or Revised projected publication date	0	
60	05-18-2010	Mail-Petition to Revive Application - Granted	0	
59	05-17-2010	Petition to Revive Application - Granted	131	53
58	03-05-2010	Petition Entered	0	
57	03-05-2010	Workflow - Request for RCE - Begin	0	
56	01-06-2010	Email Notification	0	
55	01-06-2010	Mail Abandonment for Failure to Respond to Office Action	0	
54	01-04-2010	Aband. for Failure to Respond to O. A.	0	
53	09-01-2009	Email Notification	0	
52	09-01-2009	Mail Advisory Action (PTOL-303)	0	
51	08-28-2009	Advisory Action (PTOL-303)	0	
50	08-26-2009	Date Forwarded to Examiner	0	
49	08-25-2009	Amendment after Final Rejection	0	
48	08-25-2009	Electronic Review	0	
47	08-25-2009	Email Notification	0	
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EXHIBIT C

5/25/2011

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46	06-25-2009	Mail Final Rejection (PTOL - 326)	0
45	06-22-2009	Final Rejection	0
44	06-17-2009	Date Forwarded to Examiner	0
43	03-05-2009	Response after Non-Final Action	0
42	12-12-2008	Electronic Review	0
41	12-12-2008	Email Notification	0
40	12-12-2008	Mail Non-Final Rejection	0
39	12-08-2008	Non-Final Rejection	0
37	10-05-2008	Date Forwarded to Examiner	0
36	08-27-2008	Response after Non-Final Action	0
35	05-30-2008	Electronic Review	0
34	05-29-2008	Email Notification	0
33	05-29-2008	Mail Non-Final Rejection	0
32	05-23-2008	Non-Final Rejection	0
31	04-16-2008	Date Forwarded to Examiner	0
30	04-01-2008	Amendment Submitted/Entered with Filing of CPA/RCE	0
29	04-16-2008	Date Forwarded to Examiner	0
28	04-01-2008	Request for Continued Examination (RCE)	29 22
27	04-16-2008	Disposal for a RCE / CPA / R129	0
26	04-01-2008	Request for Extension of Time - Granted	0
25	04-01-2008	Workflow - Request for RCE - Begin	0
24	12-03-2007	Electronic Review	0
23	12-04-2007	Email Notification	0
22	12-03-2007	Mail Final Rejection (PTOL - 326)	0
21	11-26-2007	Final Rejection	0
20	09-19-2007	Date Forwarded to Examiner	0

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EXHIBIT C

5/25/2011

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19	09-11-2007	Response after Non-Final Action	0
18	06-21-2007	Electronic Review	0
17	06-20-2007	Email Notification	0
16	06-15-2007	Mail Non-Final Rejection	961 0.5
15	06-07-2007	Non-Final Rejection	0
14	04-17-2007	Case Docketed to Examiner in GAU	0
13	04-12-2007	IFW TSS Processing by Tech Center Complete	0
12	04-11-2007	Case Docketed to Examiner in GAU	0
11	12-12-2006	Transfer Inquiry to GAU	0
10	08-03-2006	Transfer Inquiry to GAU	0
9	01-28-2004	Transfer Inquiry to GAU	0
8	11-19-2003	Application Return from OIPE	0
7	11-19-2003	Application Return TO OIPE	0
6	11-19-2003	Application Dispatched from OIPE	0
5	11-19-2003	Application Is Now Complete	0
4	11-10-2003	CASE CLASSIFIED BY OIPE	0
3	11-10-2003	Cleared by OIPE CSR	0
2	10-14-2003	IFW Scan & PACR Auto Security Review	0
1	08-27-2003	Initial Exam Team nn	0
0.5	08-27-2003	Filing date	0

Close Window